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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,762	02/15/2005	Werner Bonrath	K21364USWO (C038435/01843)	3414
7590	04/05/2007	Stephen M Haracz Bryan Cave 1290 Avenue of the Americas New York, NY 10104	EXAMINER GALE, KELLETTE	
			ART UNIT 1621	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/05/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/524,762	BONRATH ET AL.	
	Examiner	Art Unit	
	Kellette Gale	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 December 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Status of Claims***

Claims 1-20 are pending.

Claims 1-20 are rejected.

### ***Response to Amendment***

The recent amendment filed December 28, 2006 has been received and acknowledged by the Examiner.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant's arguments filed December 28, 2006 have been fully considered but they are not persuasive. Applicant argues that the Examiner has based the rejection on hindsight and an "obvious to prepare" theory. Applicant also argues that the genus taught by the prior art, Tedeschi et al, is too broad.

The Examiner contends that it is indeed obvious to prepare acetylenic alcohol as claimed as Tedeschi et al has given a process to do just that. Therefore, if one having ordinary skill in the art would wanted to prepare an acetylenic alcohol as claimed, one would find a process to do just that in the Tedeschi et al disclosure. This should not get confused with the "obvious to try" doctrine. Also, the Examiner contends that Tedeschi

Art Unit: 1621

et al teaches the use of acetone in his preparation. Acetone is a direct homolog of the methyl ethyl ketone claimed. Therefore, it would be obvious for one having ordinary skill in the art to utilize the process taught by Tedeschi et al in order to arrive at the same compounds or direct homologs of those same compounds as claimed by applicant.

Applicant also claims that the molar ratio of acetone:alkali metal hydroxide is much more than that claimed by applicant and that applicant claims "less than 1:200", but wherein the description in Tedeschi et al only goes as low as 1:11.9 which is still greater than that which is claimed.

The Examiner contends that Tedeschi et al have taught all of the elements of the invention and applicant has failed to show any unexpected results when using such a molar ratio. Therefore, applicant must introduce to the Examiner where there are unexpected results in order to claim the molar ratio as being patentably distinct over the prior art. Tedeschi et al is preparing the same class of compounds as the applicant has claimed; therefore it is not considered to be patentably distinct without a showing of unexpected results.

It is for these reasons and those set forth in the prior office action dated September 25, 2006 that the rejection of claims 1-20 under 35 USC 103(a) as being unpatentable over Tedeschi et al (US 3,709,946) is maintained.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kellette Gale whose telephone number is (571) 272-8038. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Kellette Gale  
Patent Examiner  
Technology Center 1600

*March 16, 2007*

*THURMAN K. PAGE*  
*IV PATENT EXAMINER*  
*TECH CENTER 1600*

Thurman Page  
Supervisory Patent Examiner  
Technology Center 1600